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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,856	02/23/2004	Mark Roland Boeder	CHRE:180	5475

7590 12/18/2006  
Charles A Wendel  
Steptoe & Johnson LLP.  
1330 Connecticut Avenue N.W.  
Washington, DC 20036

EXAMINER
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HELMER, GEORGIA L

ART UNIT	PAPER NUMBER
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1638

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/782,856

Applicant(s)

BOEDER, MARK ROLAND

Examiner

Georgia Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**Non-Final Office Action**

1. Applicant's 16 June 2005 response to the requirement for Information under 37 CFR 1.1.05 is acknowledged.

***Claim Rejections - 35 USC § 102***

2. The 35 U.S.C. 102(b) Rejection of the plant 'Sizzleness' over the PBR application number QZ PBR 011851 as set forth in the Office Action of 4/16/05 is withdrawn in light of the fact that the publication of the PBR information was 15 June 2003, which is not greater than one year before the filing of the US application on 23 February 2004.

Specifically, Applicant traverses primarily that "an error occurred in the transmission of the CPVO to the UPOV CD. The November 21, 2001 date does not correspond to the denomination proposal date but rather refers to the application date made under the breeders reference number... The Examiner is informed that the CPVO was asked to make the necessary correction and inform her accordingly. Enclosed is a copy of a letter dated May 17, 2005 from the CPVO to the Examiner stating that the denomination was proposed April 3, 2003, published June 15, 2003, and granted rights thereunder on December 8, 2003". (16 June 2005 Response, p. 1-2).

Applicant's traversal is persuasive.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by the Assignee's printed 2003 catalogue publication first distributed in November 2002 in light of the fact that the plant was sold in the Dutch auctions of 2002, and further in view of the Royal Horticultural Society Dictionary of Gardening 1992, vol. 1, pages 612-618,

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describing how to asexually propagate a chrysanthemum. See (16 June 2005 Response, p. 2, 1<sup>st</sup> full ¶). The Applicant informed the Office "that the first date of sale of 'Sizzleness' took place in the Netherlands in December 2001"(17 August 2004 Response, p.4, 1<sup>st</sup> full ¶). Applicant also enclosed copies of the PBR applications and grant, pointing out "that the application date was 21 November 2001 and the denomination 'Sizzleness' was proposed 28 March 2003, less than a year before the present case was filed"(17 August 2004 Response, p.4, 1<sup>st</sup> full ¶). The Applicant further notes that flowering stems of "sizzle" are sold through the Dutch auctions and the regular promotion and sale of Sizzle in the Netherlands took place at the end of 2002 (16 June 2005 Response, p. 2, 1<sup>st</sup> full ¶).

The published catalogue is a "printed publication" under U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, F.2d 221, 226, 210 USPQ 790, 792 (CCPA 1981). See also MPEP § 2128.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re Le Grice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could obtain or reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether 'Siokra' seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce

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the cultivar Siokra disclosed in the cited publications.”). Moreover, the Court *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) states that a printed publication coupled with a foreign sale of the plant would constitute a bar under §102(b) on page 1040.

Applicant traverses primarily: “With respect to successful reproduction of the plant, Applicant submits that reproduction is possible only after access to information regarding the parentage of the plant, information that becomes available no earlier than December 2003, less than a year before the filing date of the instant Application.” (16 June 2005 Response, ¶¶ bridging p. 2-3).

Applicant's traversal is unpersuasive. The instant cultivar was placed in the public domain more than one year prior to the U.S. filing date of this application. In *In re Elsner* (72 USPQ2D 1038 (CA FC 2004), the Court states that the “publication of the applications coupled with foreign sales of the plants may constitute a §102(b) bar to patentability” (p. 1040). Moreover, the foreign sale must not be an obscure, solitary occurrence that would go unnoticed by those skilled in the art. The sales of ‘Sizzleness’ in the Netherlands were not obscure, solitary occurrences that would go unnoticed by those skilled in the art.

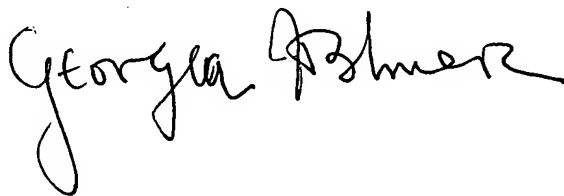
#### **Remarks**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia Helmer whose telephone number is 571-272-0796. The examiner can normally be reached on 10-6 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Georgia Helmer PhD  
Patent Examiner  
Art Units 1638/1661  
6 December 2006

A handwritten signature in black ink that reads "Georgia Helmer". The signature is written in a cursive, flowing style with a large initial "G".